

REMARKS/ARGUMENTS

Claims 41-58 and 63 were previously pending in this application. Claims 41-58 and 63 stand rejected in a non-final Office Action under 35 U.S.C. § 112, first paragraph. According to the Office Action, prosecution has been reopened in view of the applicant's appeal brief filed on July 9, 2004. In response to the above-identified Office Action, Applicant respectfully seeks reconsideration of the application in view of the remarks set forth below.

A. Rejection Under 35 U.S.C. §112, First Paragraph Based on 2 Limitations in Claim 41

Claims 41-58 and 63 of this application correspond to claims of U.S. Patent No. 5,729,603. Within the Office Action, it is stated that:

The examiner does not consider this claim [Claim 41] to be directed to the same invention as that of U.S. Patent No. 5,729,603 because the support for the copied claims is not the same as that of U.S. Patent No. 5,729,603. Accordingly, an interference cannot be initiated based upon this claim.

It appears that the basis for the rejection is that the disclosure of the present invention is not identical to the disclosure of U.S. Patent No. 5,729,603. There is no support for this position in the statute, the rules, the MPEP nor the cases. Accordingly, the Applicant respectfully requests that this basis for rejection be withdrawn. In contrast, the appropriate test for whether the specification of the present application supports the claims and not that the implementations developed by two different engineers and described in two different patent applications are identical. It is incontrovertible that the disclosure of the present application fully supports each limitation found in the invention as claimed.

Regarding claim 41, the Official Action asserts that

“the claim limitation recites ‘...a switch matrix, settable to any of a plurality of switch configurations...’. U.S. Patent No. 5,729,603 discloses that the plurality of switch configurations yields twenty-four possible combinations. However, the polarity of the signal lines is not important, thus reducing the twenty-four possibilities to 6 possible configurations as disclosed at column 4, line 32 through column 5, line 24 and exhibited in table 1. Conversely applicant's specification does not disclose the number of possible configuration [sic], thus the support for the claimed limitation is different.

This is an incorrect statement of the requirement for finding an interference and that the claims are supported by the specification. The rules require that the present application supports the invention as claimed. There is NO requirement that the disclosures be identical.

Moreover, the assertion that the applicant's specification does disclose the number of possible configurations is simply incorrect. In the applicants specification a 4x4 switch array is used (see eg. page 10, line 20). Further, the specification recites that the switching algorithms for the system are illustrated in Figures 4 and 5. *The precise number of possible configurations are clearly and unambiguously shown in Figures 4 and 5.* Additionally, the sequence of the possible configurations is shown. Thus, there is no doubt that the specification of the present application teaches a 'switch matrix, settable to any of a plurality of switch configurations...'

Next, the Official Action asserts that

"The claim further cites the limitation '...a control logic, coupled to the switch matrix, that automatically determines which of the plurality of signal lines from the handset port comprise the handset port receive path, determines a preferred switch configuration from among a plurality of switch configurations based upon which of the plurality of signal lines from the handset port comprise the handset port receive path, and sets the switch matrix to the preferred switch configuration, the preferred switch configuration coupling the handset port receive path to the headset receive path.' U.S. Patent No. 5,729,603 discloses that control logic test each of the six configurations is tested with a test signal, typically a dial tone and the result is measured via the signal level detector to determine the preferred configuration. Each of the six combination are tested sequentially and the result is compared to the previous result and the best result is used as the combination. Conversely the applicant's specification does not disclose the above process to determine the appropriate configuration. Therefore claim 41 fails to meet the requirement of MPEP 2307.02.

This is an incorrect statement of the facts. There is no doubt that the specification of the present invention includes a control logic (the MCU). See the paragraph beginning on line 5 of page 17 which states:

"The digital MCU 100 will begin manipulating the crosspoint switch array 2 by sequentially coupling pairs of the transmit output ports starting with the most probable pairs defined in the system algorithms. A description, which illustrates the system's switching algorithms, is shown in detail in Figures 4 and 5. The 1 KHz transmit calibration signal is therefore applied to the telephone base unit via the jack lines 202 until the 1 KHz signal is sensed by the digital MCU 100 at the receive level reference output RX LEVEL REF. When the digital MCU 100 senses the 1 KHz signal it will have successfully located the appropriate transmit lines and will latch the information and begin the transmit output step attenuator TX-5 adjustment.

Looking at the drawing of Figure 4 it is clear that the combinations are tested sequentially. Thus, the specification teaches that there is a control logic, which tests the configurations sequentially

with a test signal to determine the preferred configuration. **Thus, there is no doubt that the specification of the present application teaches the disputed limitations.** Because the specification teaches these limitations they do not fail under 35 USC §112 and thus, the specification and the claims satisfy MPEP 2307.02.

The claims 56, 57 and 63 are rejected for the same reasons as claim 41. Thus, these claims should be allowed for the same arguments set forth above.

The Case Law Cited Does Not Stand for the Proposition Claimed in the Office Action

Within the Office Action, Rowe v. Dror, 42 USPQ2d 1550 (Fed. Cir. 1550) is cited for the proposition that the “rule that copied claim is interpreted in light of its originating disclosure applies in context of issue of whether applicant is eligible to copy patentee’s claim” (emphasis in original). Rowe in fact does not relate to the issue of whether a claim can be copied. In that regard, Rowe refers in *dicta* to In re Spina, 975 F.2d 854, 24 USPQ 2d 1142 (Fed. Cir. 1992). Spina states:

When interpretation is required of a claim that is copied for interference purposes, the copied claim is viewed in the context of the patent from which it was copied. DeGeorge v. Bernier, 768 F.2d 1318, 1322, 226 USPQ 758, 761 (Fed. Cir. 1985) (**if claim language is ambiguous** “resort must be had to the specification of the patent from which the copied claim came”).

Spina, 975 F.2d at 856 (emphasis added). Spina does not say that the disclosures must be identical. Here, the present application and U.S. Patent No.5,729,603 both teach a plurality of combinations, a process for determining the best one and a control logic (MCU) for carrying out that process.

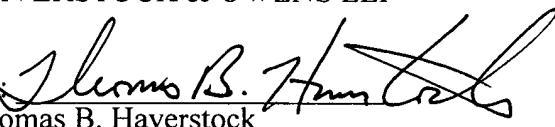
Moreover, the Office Action appears to ignore the language in Rowe that requires the claim to be interpreted in light of the specification in which it appears rather than with reference to the patent from which it was copied. **As shown above, the present specification clearly and unambiguously teaches all the limitations of the claims. Applicant respectfully asserts that the rejection under 35 U.S.C. §112 should be withdrawn.**

Conclusion

For the reasons given above, the Applicant respectfully submits that the Claims 41-58 and 63 are in a condition for allowance, and an interference should be initiated between the present application and U.S. Patent No. 5,729,603. Should the Examiner have any questions or comments, the Examiner is encouraged to call the undersigned at (408) 530-9700 to discuss the same so that any outstanding issues can be expeditiously resolved.

Respectfully submitted,
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Dated: 7-18-05

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CERTIFICATE OF MAILING (37 CFR§ 1.8(a))

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